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REMARKS

With respect to the continued reliance on *In re Harza*, the Examiner should note that the Board of Appeals has already soundly rejected the proposition that *In re Harza* amounts to some per se rule of unpatentability. Even more pointedly, the Board of Appeals has pointed out that per se rules of patentability have been precluded by the Federal Circuit. *In re Granneman*, 68 U.S.P.Q.2d 1219 (POBA 2003). Moreover, the Board pointed out that some rationale to modify must be provided from within the prior art. In other words, the reliance on some kind of per se rule out of *In re Harza* is improper and fails to make out a *prima facie* rejection.

Moreover, the Board pointed out that *In re Harza*, to the extent it has any continued validity, arise only when the only difference between the prior art and the cited reference is the mere duplication of parts. Here, we have no such situation.

In particular, the claim calls for a pair of mixers and a device to select one output of only one of the mixers. Mere duplication would provide for two mixers and two outputs. Instead, we have two mixers and only one output which would not be a mere duplication.

In view of the Board of Appeal's rejection of reliance on *In re Harza* (in the way applied here), reconsideration and withdrawal of the rejection would be appropriate.

More particularly, in *Granneman*, the Board of Appeals stated that "The Court in *Harza* stated that the only difference between the reference's structure for sealing concrete and that of *Harza*'s claim 1 was that the reference's structure had only a single reference (i.e., arm) on each side of a web, whereas the claim required a plurality of such ribs." The Board continued:

The Examiner does not compare the facts in *Harza* with those in the present case and explain why, based upon this comparison, the legal conclusion in the present case should be the same as that in *Harza*. Instead, the Examiner relies on *Harza* as establishing a per se rule that duplication of parts is obvious. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995), 'reliance on per se rules of obviousness is legally incorrect and must cease.'

The Board continued that "the Examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification."

In view of the Board's prior decision and the reasoning included therein, the reliance on *Harza* in this case as establishing some per se rule of obviousness of duplication is improper and cannot be sustained.


The Examiner makes effectively the same point in the Section 112 rejection. There, the Examiner states that "because controlling the output does not necessarily equate to selectively outputting a signal from one of the mixers," the rejection is maintained. But if this is so, the Examiner is effectively admitting that there is not mere duplication in this case and that the Section 103 rejection is improper. That is because the Examiner is insisting that language that suggests controlling the output does not equate to selectively outputting a signal and yet the Examiner contends in the same rejection that a reference that teaches one mixer teaches two and selectively controlling the output of those two mixers. It cannot be both ways.

Moreover, the specification is clear that the output of the mixer 62 and 82 is selective. For example, at page 7, line 23 through page 8, line 3 it is explained that audio programs may be swapped on the fly between the digital-to-analog converter pair 80 and the digital-to-analog converter pair 58 by software. It can be seen that the pair 58 is connected to the mixer 62 and the pair 80 is connected to the mixer 82. If the programs may be swapped, then the output must also be swapped. Then it is explained that a first channel may be recorded while watching the second channel. In other words, one channel may be recorded while the other one is output. This clearly teaches switching the output from one of the mixers. Then, on page 8, it is explained that one could easily switch to recording the second channel while watching the first channel without reconnecting cables. The specification is explicit that there is a device to selectively output a signal from one of the mixers. There would be no other way to switch on the fly, as explained, and to record a first signal while displaying a second and then to switch and to record the second signal while displaying the first.

Therefore, reconsideration of the Section 112 rejection is requested.

Respectfully submitted,

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